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Scott Fergusson

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EXAMINER

KRISCIUNAS, LINDA MARY

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/916,951 | Applicant(s) FERGUSON ET AL. | |
| | Examiner Linda Krisciunas | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-26 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the Applicant's Pre-Appeal Brief Request for Review filed April 21, 2006. Prosecution of the application will be re-opened.

Response to Arguments

2. The Examiner has fully considered the Applicant's arguments with respect to claims 1-18 and 20-26 concerning a listing of customers are provided that include a listing of the selected customers that the particular representative represents and it is deemed not persuasive. Melchione teaches (column 7, lines 19-22 and column 8, lines 51-58) sending a list of leads to the branch offices and then on to personal bankers within the branch where the banker contacts his/her particular list of leads which constitutes that banker being that lead's particular representative.

The Examiner has fully considered the Applicant's arguments with respect to claims 1-18 and 20-26 concerning providing marketing material to the customer from the representative that represents him/her, and it is deemed not persuasive. Melchione teaches the personal bankers that represent their list of leads, or customers, contacting the lead during a marketing campaign with their promotions and also teaches a relationship building feature that delivers prioritized call lists on-line and tracks results; a promotional suppression facility that provides information on customers and non-customers who do not wish to be contacted by telephone and/or mail; and a contact history feature that displays recent promotional contacts to each customer (column 9, lines 26-29).

The Examiner has fully considered the Applicant's arguments with respect to claims 1-18 and 20-26 concerning determining which of the customers actually purchased the product from those that were contacted and received marketing material, and it is deemed not persuasive. Melchione teaches (column 9, lines 13-67 and column 10, lines 1-8) the CCIS system which tracks the customers profile including what promotions they have been contacted about as well as what services or accounts they have with the bank. In addition, the CCIS system tracks and reports on daily sales information, which is another means to indicate what customers purchased the product since the results for campaigns are used to track the performance and make adjustments to campaigns.

The Examiner has fully considered the Applicant's arguments with respect to claim 10 concerning the marketing material is personalized to appear to be from the representative, but is deemed not persuasive. Melchione teaches one of the means of sending the marketing material is via telephone call. Since the information is being spoken by an actual person representing the bank this constitutes the material being personalized to be from a representative.

The Examiner has fully considered the Applicant's arguments with respect to claims 20-24 concerning providing a customized listing to each representative, but is deemed not persuasive. Melchione teaches providing a list of leads to each branch and subsequently to each personal banker as indicated in claim 1. Melchione teaches utilizing a database and a computer which has software that allows interaction with the tables and structures of the database (column 8, lines 32-41) which means the list of

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leads would be sent in an electronic format so that they can be accessed by the bankers and thus an electronic list of customers would be compatible with printing labels, envelopes, post cards, merge process (column 16, lines 30-44), spreadsheet programs or e-mail programs.

The Examiner has fully considered the Applicant's arguments with respect to claim 25 concerning providing a notice announcing a marketing project to the representatives, and it is deemed not persuasive. Melchione teaches the bank management deciding on a sales promotion or marketing project and informing the marketing center such that leads can be generated and sent to the bankers at the branches (column 7, lines 13-22). In addition, Melchione teaches tracking the results of the sales promotion and the individual representatives (column 10, lines 1-8) which inherently means the representatives were notified of the promotion since they are contacting customers to sell it. A marketing appeal indicator is a measure of the performance of the marketing plan which is equivalent to Melchione tracking the performance of the campaign (column 10, lines 4-5) since it performs an identical function in substantially the same manner with substantially the same results.

The Examiner has fully considered the Applicant's arguments with respect to claims 14 and 18 concerning the use of Official Notice, and it is deemed persuasive. The rejection is no longer anticipated, but is deemed to be obvious in light of the art provided.

The Examiner has fully considered the Applicant's arguments with respect to claims 19 and 31-35 concerning the use of 17 CFR Part 24, but is deemed not

persuasive. 17 CFR Part 24 is federal law required for those in the financial or banking industry, which is analogous to Melchione since they are in the same field of endeavor. There is motivation to combine the references due to them being in the same field of endeavor, in addition to the fact that federal law requires adherence to these regulations.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-13, 15-17, 20-22 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Melchione et al. (US 5,930,764).

As per claim 1, Melchione teaches a method for monitoring the efficacy of a marketing project for a product of a business, the method comprising the steps of: providing a customer database (10) for storing information about the customers of the business; providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); notifying at least some of the selected customers about the product (column 27, lines 45-48); determining which of the customers that were notified about the product actually purchased the product; and determining a marketing project efficacy indicator (column 9, line 67 and column 10

lines 1-6) by noting which of the customers that were notified about the product actually purchased the product (column 40, line 59 and column 6, lines 49-51).

As per claim 2, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were notified about the product with the number of the customers that were notified about the product and actually purchased the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that.)

As per claim 3, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were notified about the product with the number of the customers that were notified about the product and did not purchase the product. (Melchione also discloses a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that.)

As per claim 4, Melchione teaches a method further comprising the step of monitoring revenues generated from the purchase of the product by the customers that were notified about the product. (Revenue calculations (column 41, line 66) would monitor revenues generated from product sales.)

As per claim 5, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the revenues generated from the sale of

the marketed product relative to a revenue goal. (Revenue calculations (column 41, line 66) and goal reports (column 41, line 51) are efficacy indicators.)

As per claim 6, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of products sold versus a goal. (Revenue calculations (column 41, line 66) and goal reports (column 41, line 51) would be efficacy indicators.)

As per claim 8, Melchione teaches a method of modifying the marketing material if the marketing project efficacy indicator is deemed to be too low. (Means for modifying said campaign if not optimal, wherein the campaign encompasses all aspects of the marketing program (column 10, lines 4-6).)

As per claim 9, Melchione teaches a method of modifying selected marketing project parameters if the marketing project efficacy indicator is deemed to be too low. (Means for modifying said campaign if not optimal, wherein the campaign encompasses all aspects of the marketing program (column 10, lines 4-6).)

As per claim 10, Melchione teaches a method for marketing a product to customers of a business, wherein the business has a number of representatives, and each representative represents a portion of the customers, the method comprising the steps of: providing a customer database for storing information about the customers of the business(10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); providing at least a partial listing of the selected customers to one or more of the representatives; at least some of

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the representatives providing information about the product to at least some of their customers listed on the at least partial listing. (Melchione teaches the concept of “representatives” and their contact with customers (column 62, lines 31-34) wherein the branch workstations are deemed equivalent to the term “representative” as they perform the identical function in substantially the same manner and produce substantially the same results.)

As per claim 11, Melchione teaches a method for monitoring how many and/or which of the customers that were provided marketing information about the product actually purchased the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 12, Melchione teaches a method of determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with marketing information about the product actually purchased the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this

performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 13, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were provided marketing information with the number of those customers that were provided marketing information that actually purchased the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 15, Melchione teaches a method of monitoring how many and/or which of the customers that were provided marketing information about the product did not purchase the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 16, Melchione teaches a method for determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with marketing information about the product did not purchase the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 17, Melchione teaches that the marketing project efficacy indicator is determined by comparing the number of customers that were provided marketing information with the number of those customers that were provided marketing information that did not purchased the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 20-22, Melchione teaches a method wherein the at least partial listing of the selected customers is provided to the one or more representatives in a format that is compatible with: printing labels, printing envelopes or post cards and a merge function of an application program.(Melchione already teaches targeted marketing techniques used including direct mailing, telemarketing and computer banking (column 4, lines 8-37), as well as a means for downloading reports and files to local printers or storage devices (column 8, lines 49-50) and a merge process (column 16, line 33).

As per claim 25, Melchione teaches a method for marketing a product to customers of a business, wherein the business has a number of representatives, and each representative represents a portion of the customers, the method comprising the steps of: providing a customer database for storing information about the customers of the business (10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); providing at least a partial listing of the selected customers to one or more of the representatives; at least some of the representatives providing information about the product to at least some of their customers listed on the at least partial listing (column 62, lines 31-34); identifying those customer that were provided with information about the product; identifier those customer that actually purchased the product (column 40, line 59); and determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with information about the product actually purchased

and/or did not purchase the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 26, Melchione teaches a method wherein the at least partial listing of selected customers is provided to one or more of the representatives upon initiation by the representative. (See Figure 1A, where the Micromarketing centers or "representatives" request information from the database to obtain the customer information.)

As per claim 28, Melchione teaches a method for making a contact entry in the customer database when a representative contacts a customer about the product; and determining a marketing project appeal indicator by monitoring the contact entries in the customer database. (Melchione teaches a tracking and reporting management tool for daily sales and to track performance (column 33, lines 61-66).)

As per claim 29, Melchione teaches a method wherein the at least partial listing of the selected customers that is provided to a particular representative only include customers that the particular representative represents. (Melchione teaches leads which are distributed among selected bankers within the branch (column 33, lines 39-45).)

As per claim 30, Melchione teaches a method wherein an identifier for each customer that actually purchased the product is generated by having each

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representative initiate the recording of each sale of the product in the customer database. (Melchione discloses tracking and reporting management tools for daily sales and to track performance (column 33, lines 61-66).)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 18 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al (US 5,930,764).

As per claim 14, official notice is taken for determining common characteristics for those customers that actually purchased the product from a representative of the business. Official notice is taken that both the concept and the advantages of determining common characteristics for customers that purchased the product are well known and expected in the art. It would have been obvious to conduct research on customers to better understand their motivation for purchasing the product. (References were previously provided in the Advisory Response filed April 5, 2006 to substantiate the Official Notice.)

As per claim 18, official notice is taken of a method for determining common characteristics for those customers that did not purchase the product from a

representative of the business. Official notice is taken that both the concept and the advantages of determining common characteristics for customers that did not purchase the product are well known and expected in the art. It would have been obvious to conduct research on customers to better understand their motivation for purchasing and not purchasing the product. (References were previously provided in the Advisory Response filed April 5, 2006 to substantiate the Official Notice.)

As per claims 23-24, Melchione teaches a method wherein the at least partial listing of the selected customers is provided to the one or more representatives in a format that is compatible with a spreadsheet application program and compatible with an e-mail program. Melchione teaches utilizing a database and a computer which has software that allows interaction with the tables and structures of the database (column 8, lines 32-41) which means the list of leads would be sent in an electronic format so that they can be accessed by the bankers and thus an electronic list of customers would be compatible with printing labels, envelopes, post cards, merge process (column 16, lines 30-44), spreadsheet programs or e-mail programs. Official notice is taken that it is old and well known for database programs to interact with other electronic software packages, such as Microsoft Office which has a database package Access and Excel a spreadsheet package and Outlook an e-mail package that interface with each other, that provide e-mail, spreadsheet and printing capabilities. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the database of Melchione to be compatible with other software applications to allow additional functionality with respect to data output and formatting.

7. Claims 19 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione, in view of 17 CFR Part 248 which is a financial services regulation related to Privacy of Consumer Information.

As per claim 19, Melchione teaches a method wherein the business is a financial services business, the method further comprising the steps of: generating marketing material; checking the marketing material for compliance with applicable rules and regulations, thereby resulting in compliant marketing material; providing the compliant marketing material, as well as the at least partial listing of selected customers, to the one or more of the representatives. (Melchione teaches the "financial services business" in equivalent terms as a financial institution (column 5, line 61), as well as marketing campaigns (column 8, line 54) which is deemed equivalent to marketing material as it performs an identical function in substantially the same manner and generates substantially the same results. This material is distributed to the "representatives" as previously mentioned in claim 10. Melchione does not explicitly teach the requirement of having financial materials comply with a standard. But, official notice is taken of 17 CFR Part 248 which teaches that it is known for a financial institution to comply with various standards such as those forth in the Gramm-Leach-Bliley Act concerning the Privacy of Consumer Financial Information. Since these are mandated laws in the United States, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the database as taught by Melchione with compliance requirements as taught by 17 CFR Part 248, since such a modification

would provide the database with a means for maintaining the current level of security required for financial documents.)

As per claims 31-35, Melchione teaches generating marketing material (column 5, lines, 51-57: "The present invention provides a tool for establishing a long term and broad relationship with a customer by allowing those in charge of marketing financial services to access and discuss the full range of financial services presently used by the customer, as well as to only target optimum groups of customers for each marketing campaign conducted"); providing a customer database for storing information about the customers of the business (10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); providing the compliant marketing material and a customized listing of the selected customers to at least some of the representatives (column 9, lines 44-52: "The branch managers receive the list of leads generated by the micromarketing center and electronically load the leads into the CCIS workstations for distribution among selected personal bankers within the branch. The branch managers assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers."); and at least some of the representatives providing the compliant marketing material to at least some of the customers listed on their customized listing of selected customers (column 9, lines 55-57: "The personal bankers then conduct sales sessions (e.g., telephone calls) with each of the customers on the list of leads.") and determining common characteristics for the customers that purchased the product

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(column 7, lines 65-67: "the central database is housed in a mainframe computer and includes a large repository of financial and demographic data." and column 8, lines 17-31: "Thus, the central database serves as a single central repository for storing all customer related information throughout the business. As described hereinafter, the central database can be used for a wide variety of customer service, financial analysis and marketing purposes. While a single central repository for storing all customer related information throughout a business offers significant potential, the database is necessarily so large that certain problems arise. For example, the present inventors recognize that a database of this size cannot practically be directly searched. Thus, in accordance with another aspect of the present invention, the system of the present invention includes means for allowing users to dynamically build programs for searching the central database" whereby it would be inherent that the database would sort the customers according to common characteristics.). Melchione does not explicitly teach checking the marketing material for compliance. Official notice is taken that 17 CFR Part 248 teaches that it is known to have compliant information in the banking/financial arena as these are mandated laws. Therefore it would have been obvious to one of ordinary skill in the art to combine the customer marketing database system of Melchione with the compliance features of 17 CFR Part 248 to provide a more comprehensive and marketable system.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-

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6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

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May 10, 2006


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